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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,651	08/07/2001	Kevin P. Headings	108.0010-00000	9189
22882	7590	02/01/2008		
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3600	PAPER NUMBER
			MAIL DATE 02/01/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/922,651

Applicant(s)

HEADINGS ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10-25-07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-22 and 41-49 have been examined.

Response to Amendments/Arguments

2. Applicant is of the opinion that the prior art of does not teach providing for the aggregation of selected media content offerings (i.e. combining media assets based on a business rule) into two rollouts, offering a first rollout to a first grouping of consumers and offering a second rollout to a second grouping of consumers. offering is being offered to at least one of the selected groupings of the consumers, and a rollout specific to the selected groupings. The Examiner respectfully disagrees with Applicant's assessment.

Initially, the Examiner would like to reiterate that claims 1 and 41 describe an apparatus that is "adapted to provide for" the combination of media assets and metadata, for example. However, this is merely functional language, and it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, as Downs et al. disclose the structure of Applicant's system (figures 1A (items

151, 156, and 162), 1B (items 103 and 180), 1C (items 182-184) and 1D (item 111; column 18, step 129) it is sufficient in terms of art. The language "adapted to provide for" is also broad. Consider, for example, a PC on the shelf at a Best Buy. The PC is "adapted to provide for" buying stocks on the internet as it is *adapted* for internet access and *provides* an interface (i.e. Internet Explorer) that enables a user to set-up an account and select stocks online. It has also been held that a recitation directed to the manner in which a claimed apparatus is *intended to be used does not distinguish* the claimed apparatus from the prior art- if the prior art has the capability to so perform (*Ex parte Masham*, 2 USPQ2d 1647 (1987)). Hence, Downs et al. is again sufficient in terms of art.

Nonetheless, Downs et al. teach placing multiple items for purchase (column 29, lines 30-35) in a single container (column/line 28/15-30/62) (i.e. aggregating content) and making the content available at a content hosting site a (column/line 70/40-72/63) such as Columbia House Online (column 70, lines 43-59; column/line 71/65-72/4). Downs et al. also teach that these sites offer incentives, establishes customer loyalty and markets products as is known in the art (column 72, lines 8-11). Therefore, as Swix et al. teach collecting user demographics and selections then using the collection to provide content to users (abstract; column/line 1/43-2/2; column 2, lines 30-48; column 3, lines 48-64), the combined prior art at least suggests to one of ordinary skill identifying the a first group of customers who like Mariah Carey, a second group

of customers who like Morrissey and offering new Mariah and Morrissey albums at a discount as part of an incentive or loyalty program ('618, figure 16; column 72, lines 8-11).

The following assertions of fact have gone unchallenged and are considered admitted prior art:

- determining what products to offer based on sales and customer demographics

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. U.S. Patent 6,226,618 in view of Swix et al., U.S. Patent 6,718,551.

As per claims 1-22, and 41-49 Downs et al. teach a system for providing content to users comprising:

- a (local) content database or repository storing the media content offering delivered from said content management system, a rack that receives the media content offering from said content management system, said rack including a file repository for storing media content associated with the media content offering and a server distributing media content stored in said file repository (figures 1D, 5, 6, 10 and 14; column/line 68/47-70/39)
- a processor that combines media assets and metadata (figure 1) combining media assets and metadata based on selected groupings of the consumers to create a media content offering for each selected grouping of the consumers, said content management system selecting the media content offering for distribution to the selected groupings of the consumers based on at least one of a geographical location, a bit rate service, a service provider, and a contractual term (e.g. specifying a provider) and to aggregate the selected media content offering into a rollout available for exhibition to the consumers (column 26, lines 5-30; column 39, lines 10-20; column 48, lines 45-50; column 54, lines 30-35; column 59, lines 15-30; column 69, lines 1-27)
- a subscriber management system for creating a plurality of subscriber accounts, said subscriber management system including at least one processor and at least one medium for storing subscriber account information, said processor being operable to maintain the subscriber

accounts and includes a procedure for billing the subscriber accounts, said subscriber management system being operable to group individual consumers into the selected groupings for receiving selected media content -offering specific for at least one of the selected groupings (column 23, lines 15-20; column/line 45/65-47/25)

- subscriber management system processor that manages consumer-related information, further comprising a database for storing the consumer related information (e.g. billing, demographics) (column 23, lines 15-20; column/line 45/65-47/25)
- collecting information associated with the use of media content selected from the media content offering by each consumer (e.g. content use information includes consumer media content preferences) (column 23, lines 15-20; column/line 45/65-47/25)
- server for licensing content and license terms or rules (e.g. content offer expires after a length of time, price) (column 25, lines 20-35; column 26, lines 5-35; column 59, lines 33-67)
- license includes a decryption key program adapted to decrypt media content that is encrypted (column/line 81/62-82/5; column 83, lines 2-15)
- subscriber management processor checking an accounts database and determine whether the consumer is permitted to use the selected media content (column 23, lines 15-20; column/line 45/65-47/25)

Regarding first and second groupings, Downs et al. teach placing multiple items for purchase (column 29, lines 30-35) in a single container (column/line 28/15-30/62) (i.e. aggregating content) and making the content available at a content hosting site a (column/line 70/40-72/63) such as Columbia House Online (column 70, lines 43-59; column/line 71/65-72/4). Downs et al. also teach that these sites offer incentives, establishes customer loyalty and markets products as is known in the art (column 72, lines 8-11). For example, it is well known to those of ordinary skill in retail to determine what products to offer based on sales and customer demographics. Swix et al. teach collecting user demographics and viewing habits (e.g. length of time) then using the collection to provide content to users (column/line 1/43-2/2; column 2, lines 30-48; column 3, lines 48-64). Downs et al. disclose a store for distributing content to end-users (column/line 9/60-10/35). Swix et al. teach an ad manager collecting user demographics and viewing habits then using the collection to provide content to users (column/line 1/43-2/2; column 2, lines 30-48; column 3, lines 48-64). Therefore, it would have been obvious to one of ordinary skill for the store of Downs et al. to use stored transaction data (e.g. what was purchased, identity of purchaser) ('618, figure 16; column/line 45/65-47/5; column 72, lines 8-11) to choose (i.e. refresh or update it's database of offerings) what content (e.g. Mariah Carey, Morrissey, etc.) it makes available to consumers. And, to one of ordinary skill "selected groupings

of consumers" are those consumers that have been targeted using the method disclosed by Swix et al. for ads promoting certain artists (e.g. Mariah Carey).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- McEvoy et al. disclose tracking information about a customer, customer activity and using this data to determine new products (e.g. for testing)

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

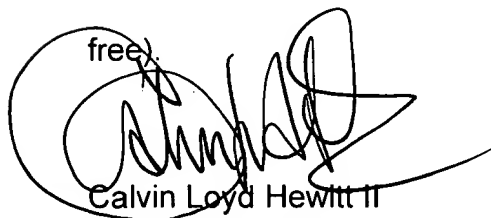
Art Unit: 3621

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free)

Calvin Loyd Hewitt II
Primary Examiner
January 15, 2008